SUPREME COURT, U.S.

IN THE

Supreme Court of the United States

October Term, 1970

No. 1165

QUINN, INC. and PAUL H. HAGEMEN,

Petitioners,

vs.

MERCANTILE NATIONAL BANK OF CHICAGO, HAROLD I. SUTTON, SUTTON MANUFACTURING COMPANY, INC., and SEBRING MANUFACTURING COMPANY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970.

No. 1145

QUEST, INC. AND PAUL E. MAGERS,

Petitioners,

vs.

MERCANTILE NATIONAL BANK OF CHICAGO, HAROLD I. SNYDER, SNYDER MANUFACTURING COMPANY, INC., AND ZIMMER MANUFACTURING COMPANY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FOREWORD.

The petition should be denied. This is a routine patent case. It presents no unusual question of law. There is no conflict in the decisions of the several Courts of Appeal with respect to the duty of a patent applicant to disclose pertinent known prior art to the Patent Office. Petitioners are in the anamolous position of asserting that it is a patent applicant's duty to call the attention of the Patent Office

to prior art which, as has been held by both the District Court and the Court of Appeals, neither anticipates the claimed invention (35 U. S. C. 102) nor renders it obvious (35 U. S. C. 103), and which is in fact, no more pertinent than references of record before the Patent Examiner.

STATEMENT OF THE CASE

If the facts of this case present any question, it is:

> "Absent any evidence to the contrary, has not a patentee established that his duty of disclosure has been fulfilled when his patent has been adjudged valid by both the District Court and the Court of Appeals, in respect to all prior art which the defendant asserts to exist?"

Certainly, such proposition admits of no issue cognizable by this Court.

A. The Invention.

At least three methods have been known to medical science for effecting wound drainage. These are: (1) gravity drainage, (2) pressure dressings, and (3) negative pressure or suction. The invention of the patent in suit provides a new concept and combination in apparatus for effecting the third and last of these techniques.

Apparatus utilizing the gravity method is disadvantageous in that the position of the patient can adversely affect the efficiency of the drainage. Also, there is no internal force to draw the severed tissues together; and the patient cannot be made ambulatory.

Compression bandages are commonly used, but these are thick and bulky and become soaked with blood and other exudate necessitating frequent changes. As with gravity drainage, compression bandages provide no internal force to pull tissue together.

The third technique for accomplishing wound drainage is frequently referred to as "closed wound suction"; and the more common apparatus which has been used for effecting it includes the electrically powered vacuum pump, or a central suction system having individual outlets in the various hospital rooms. The electric pump has a number of disadvantages including high initial cost, the need for a large number of units and correspondingly large storage space, plus the need for frequent cleaning and maintenance. In addition, the electric powered vacuum pump is noisy, presents an explosion hazard in the presence of oxygen, and restricts the activity of the patient, delaying post-operative exercise, ambulation and rehabilitation. The central suction system has many of the disadvantages of the electric vacuum pump when used for closed wound suction.

In contrast to these prior art arrangements, the apparatus of the patent in suit provides a self-contained, independently operable, evacuator for continuously applying a sustained negative pressure to the wound of a patient, while permitting the patient to be ambulatory and disconnected from any other mechanical suction source. The device may be put into operation merely by the manipulation of the container and the container outlet valve. If a tube connection is found to be faulty, the leaky connection can be fixed and the device reactivated merely by a second compression operation. Likewise, when the container becomes filled, it can be emptied and reactivated in the same manner. The device may be used in a doctor's office or a hospital location where there is no other vacuum equipment available. It may be sterilized and pre-packaged to insure sterility; and it is relatively inexpensive and yet reliable in operation and can be used to apply a continuous and sustained negative pressure to a wound over protracted periods.

Respondents' patent is not restricted to any particular

surgical operation, but may be used for surgical operations generally, including those listed in the patent specification, column 2, beginning at line 15. One such listed application, it should be noted, is in abdominal surgery.[1]

B. Prosecution of the Patent in Suit.

Petitioners quote (page 5) three passages from the file wrapper contents in argument that what is set forth is not true. Such is not the case. A more complete quotation of the first of the passages in question is as follows:

> "While this combination may appear to the Examiner to be met by Blair, it is believed clear that the two structures are completely dissimilar, for different purposes and the patentee obviously was not concerned with the problems of the present invention nor a solution thereof but merely to provide means for quickly drawing liquid into the syringe from which it is to be expelled. The ultimate purpose of the patented structure is to discharge a supply of liquid at a desired point, the filling of the syringe being only incidental to the end use of fluid discharge. It is submitted that the combination of Claim 3 presents a completely new combination which is not in any way suggested or described in the art cited and such combination has provided an entirely new concept in surgical procedure. Clearly, Blair does not disclose the combination of a container for creating a sustained negative pressure in the tubing adapted to be inserted in the human body, the tubing being non-collapsible so that it may be placed in the wound and effect drainage therefrom."

Petitioners ignore the simple fact that the patent applicant had provided a new concept, and a new combination in surgical apparatus which was defined in the claims ulti-

1. Abdominal surgery is what is disclosed in the Calicchio Patent No. 2,593,980 which was made of record by Respondents before the Patent Examiner, and which Petitioners erroneously assert does not relate to surgical procedures.

mately allowed. Respondents never attempted to claim a surgical method in the course of the entire prosecution of their patent application.

C. The Prior Art Considered by the Patent Office.

Petitioners are in manifest error on the topic of what was before the Patent Examiner. The Calicchio Patent No. 2,593,990 (DX 30-H), contrary to assertions by Petitioners, clearly constitutes prior art having reference to closed wound suction techniques. In Calicchio, a perforated tubing segment 2 is situated in an internal operative site and is lead outwardly of the human body through a stab wound 9 disposed laterally of the surgical incision 6, the latter being ultimately closed by sutures 11. The external end of the tubing is connected to a bottle suction apparatus 12-20 by means of an intermediate hose section 21. The apparatus is suggested for use in abdominal surgery. This is clearly prior art considered by the Examiner and showing closed wound suction employing a bottle suction device. The applicants voluntarily called this reference to the attention of the Patent Examiner.

D. The Prior Art Which Petitioners Assert, Is No More Pertinent.

Petitioners urge that two published articles are so significant that they should have been called to the attention of the Patent Office. Both were held by the District Court and by the Court of Appeals neither to anticipate (35 U. S. C. 102) nor to render obvious (35 U. S. C. 103) the applicants' invention. The first of these, Redon (DX 55-L), is no more pertinent than the Calicchio patent which was considered by the Patent Office Examiner. Both disclose closed wound suction apparatus employing a bottle suction device. The Examiner allowed the claims of the patent in suit over the

Calicchio reference; and both the District Court and the Court of Appeals have determined that the claims of the patent in suit are valid over both Calicchio and the publication references. The gist of Respondents' patent is the provision of a portable, self-contained, independently operable, and continuously acting device usable to apply a predictable and maintained negative pressure over protracted periods to effect closed wound suction. Bottle suction, which requires a suction pump to activate it, is not such apparatus.

The other publication which Petitioners assert is so significant is Moloney (DX 55-O). There is no evidence that the syringe mentioned by Moloney was successfully used anywhere, by anyone, for closed wound suction, at any time. It is not now nor never has been in commercial use for closed wound suction. A reading of the Moloney publication (DX 55-O) clearly shows that the passage upon which the Petitioners' rely is a casual remark by the author referring to the proposed or supposed work of prior investigators as reported in other literature. Insofar as Dr. Moloney himself is concerned, he does not even state that he ever used the syringe, or attempted to use it; and each and every one of the illustrations and all of the specific descriptions throughout the Moloney article refer to other kinds of apparatus for effecting closed wound suction, such as the central suction system or a suction pump. This sort of information is certainly less pertinent than the Calicchio patent which the Examiner considered.

REASONS FOR DENYING THE WRIT.

1. There Is No Disagreement Among the Courts on the Duty of a Patent Applicant to Disclose Information to the Patent Office.

The *Precision Instrument Case*[2] is still the law, and the cases are in agreement that a patent applicant is obligated to disclose information known to him that would render his patent invalid. The fact that one reported decision contains the catch phrase "uncompromising duty" and others use a different form of expression does not create a conflict of decision.

Petitioners cite *Wen Products Inc.* v. *Portable Electric Tools, Inc.*, 367 F. 2d 764, as authority for the alleged liberal standard applied in the Seventh Judicial Circuit. In the *Wen Products* Case, the patent was held valid; and this holding was affirmed by the Court of Appeals. The patentee had knowledge of a prior patent, but the courts found that this reference did not disclose the features of the Wen Patent and did not embody the invention of the claims in suit. Obviously, there is no duty to disclose non relevant prior art patents of which there are millions.

Petitioners cited *Admiral Corp. v. Zenith Radio Corp.*, 296 F. 2d 708, for the so-called liberal attitude in the Tenth Judicial Circuit. In this case, the patent also was held valid, and this decision was affirmed by the Court of Appeals. The known patent which was not cited by the applicants was a "significantly different prior patent".

Petitioners cite *United States* v. *Standard Electric Time Co.*, 155 F. Supp. 949, for a purported liberal standard in the First Judicial Circuit. This was an unusual suit by the government for cancellation of a patent, validity was not

2. *Precision Instrument Manufacturing Co.* v. *Automotive Maintenance Machinery Co.*, 324 U. S. 806 (1945).

directly in issue; and the Court did not cancel the patent for failure of the applicant to disclose certain scholastic theses of which he had knowledge. Nothing follows from this case contrary to the accepted rule of law.

Petitioners cite *Beckman Instruments, Inc.* v. *Chemtronics, Inc.*, 428 F. 2d 555, for the alleged more stringent requirements imposed in the Fifth Judicial Circuit. However, the Court of Appeals there, *unlike in the three preceding cases, found the patent invalid; and the information which was withheld by the applicant was the basis for the finding of invalidity.* It would seem that this holding is normal and proper since certiorari has recently been denied, L. Ed. 2d (unofficially reported in volume 167 of the United States Patent Quarterly).

In all of the cases cited by the Petitioners, and in all of the decisions of which Respondents are aware, in those cases where the patent or patents were held invalid, the fraud issue was reached and examined; but where the patent was held valid over the known art, i.e. where the known art urged by the defendant was not material, no fraud was found. This is as it should be, because to require an applicant to disclose information which does not affect validity would be to require the production of an unrealistic, useless and unending flood of information on the Patent Office.

2. To Give a Defendant in an Infringement Action a Remedy Under the Anti-Trust Laws Merely for Defending Against the Action Where No Issues of Monopoly Are Involved Would Go Too Far.

The U. S. patent system has served the nation well. Innovation has been stimulated, and small businesses are born and grow. By reason of the product of the patent in suit; untold scores of surgical patients have been made quickly

ambulatory and set on the road to recovery. Truly, the product of the patent in suit has contributed significantly to the medical profession and to mankind.[3]

If the rule urged by Petitioners were to be enacted, few patentees would seek to enforce their rights and risk treble damage liability. To arm an infringer with such a weapon would come close to silencing patent enforcement; and as a result, business would be conducted in greater secrecy with the concommitant temptations to fix prices, divide markets and generally suppress competition.

It is neither necessary nor reasonable to suggest that the anti-trust laws should be activated, in a patent case or in any case, absent the factor of monopoly or the capability of creating a monopoly, which is the only reason for the existence of anti-trust laws and anti-trust litigation.

CONCLUSION.

The patent involved in this case has been held valid by both the District Court and the Court of Appeals. The validity of this patent has been thoroughly tested and reviewed against: (1) all of the prior art cited by the Examiner, (2) all of the prior art known to the patentees, and (3) all of the prior art that Petitioners could locate including that which is now urged before this Court.

The petition should be denied.

Respectfully submitted,

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3. Petitioners in their petition (page 7) do not mention that they were offered a license under the patent in suit (PX 39) and did not give Respondents the courtesy of a reply.